

REMARKS

Claims 1-20 are pending in this application. By the Office Action, the specification is objected to; claims 15, 18 and 19 are rejected under 35 U.S.C. §112, second paragraph; claims 13 and 15-19 are rejected under 35 U.S.C. §112, first paragraph; claims 7-10 are rejected under 35 U.S.C. §103(a); and claims 14 and 20 are withdrawn from consideration. By this Amendment, claims 13-20 are amended. In view of the amendments and the following remarks, reconsideration and allowance are respectfully requested.

Applicants gratefully acknowledge that the Office Action indicates that claims 1-6 and 12 contain allowable subject matter, and that claim 11 would be allowable if rewritten in independent form.

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Janis Dote in the July 8, 2003 personal interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks. Specifically, claims 13-20 are amended and a Rule 132 Declaration comparing the closest prior art is provided to comply with the Examiner's helpful suggestions made during the interview.

I. Objection to specification

The Office Action objects to the specification stating that the specification does not disclose the conditions and the standard used to determine the Asker C hardness values. The Office Action alleges that it would require undue experimentation for a person of ordinary skill in the art to determine the rubber hardness recited in the claims. The Office Action thus concludes that the specification fails to disclose essential information necessary to describe and enable the claimed subject matter.

Applicants traverse the rejection for at least the reason that one of ordinary skill in the art would not have to make use of undue experimentation in order to determine the rubber hardness levels of original claims 18 and 19. It would require nothing more than routine experimentation for one of ordinary skill in the art to determine the originally claimed rubber hardness levels as taught in the specification. Nevertheless, only to advance prosecution of this application, Applicants amend claims 18 and 19 to delete the featured rubber hardness by Asker C. Thus, as discussed at the June 8, 2003 Examiner interview, the specification no longer lacks essential subject matter and discloses all the information necessary to fully describe and enable the claimed subject matter.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the objection.

II. Claim rejection under §112, second paragraph

The Office Action rejects claims 15, 18 and 19 under 35 U.S.C. §112, second paragraph. The Office Action rejects claim 15 on the grounds that it is allegedly not clear whether the toner image having the featured glossiness refers to before or after fixing. The Office Action rejects claims 18 and 19 alleging that the rubber hardness by Asker C renders these claims indefinite.

Applicants respectfully traverse the rejection of claims 15, 18 and 19 for at least the reason that one of ordinary skill in the art would have understood the scope of the claimed subject matter. However, in order to moot this rejection and advance prosecution, Applicants amend claim 15, as well as claim 20, to clarify the glossiness, and amend claims 18 and 19 to delete the rubber hardness feature. The amendments in no way narrow the scope of the

claims. Thus, as discussed at the June 8, 2003 Examiner interview, amended claims 15, 18 and 19 satisfy the requirements of 35 U.S.C. §112, second paragraph.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

III. Claim rejection under §112, first paragraph

A. Claims 18 and 19

The Office Action rejects claims 18 and 19 under 35 U.S.C. §112, first paragraph, alleging that the claimed image forming process featuring rubber hardness by Asker C is not sufficiently enabled by the specification. Applicants respectfully traverse the rejection for at least the reason that one of ordinary skill in the art would have been enabled to use the claimed image forming process that includes the claimed rubber hardness. However, in order to moot this rejection and advance prosecution, Applicants amend claims 18 and 19 to delete the featured rubber hardness by Asker C. The amendments in no way narrow the scope of the claims. Thus, as discussed at the June 8, 2003 Examiner interview, amended claims 18 and 19 fully satisfy the requirements of 35 U.S.C. §112, first paragraph.

Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

B. Claims 13 and 15-19

The Office Action rejects claims 13 and 15-19 under 35 U.S.C. §112, first paragraph, on the grounds that independent claim 13 is broader than what was originally disclosed in the specification including the original filed claims. Specifically, the Office Action takes the position that the fixing step using "at least one roller" in claim 13 is broader than a fixing step that includes "using a heat roller and a press roller, . . . surfaces of the heat roller and the

press roller, . . . and a releasing liquid is not substantially supplied to the surfaces" (emphasis in original).

Applicants respectfully traverse the rejection and do not necessarily agree that any feature recited in claim 13 is broader than the original disclosure. However, in order to moot the rejection and to advance prosecution, Applicants amend claim 13, as well as claim 14, as discussed at the June 8, 2003 Examiner interview.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 13 and claims 15-19 dependent thereon.

IV. Claim rejection under §103

The Office Action rejects claims 7-10 under 35 U.S.C. §103(a) over U.S. Patent No. 5,250,382 to Shimojo et al. ("Shimojo") combined with U.S. Patent No. 5,079,123 to Nanya et al. ("Nanya"). Applicants respectfully traverse the rejection for at least the following reasons.

Claim 7 is directed to a toner that includes a binder resin, a colorant, and a wax, wherein the molecular weight by GPC of the THF dissolved components of the toner is distributed in a range of not larger than 1×10^6 , the value of the differential molecular weight distribution of the molecular weight 5×10^3 is not larger than 0.55%, and the value of the differential molecular weight of the molecular weight 1×10^5 is not larger than 0.15%.

The Office Action cites Shimojo for teaching a two-component developer including a binder resin having a domain-matrix structure comprising a domain resin and a matrix resin, and points specifically to Example 31 in Shimojo. The Office Action recognizes that Shimojo does not disclose that its toner has the "molecular weight by GPC properties of the THF dissolved components of the toner" of claim 7, but the Office Action concludes that it is

reasonable to presume that Shimojo's toner has these molecular weight requirements and places the burden on Applicants to prove otherwise. Applicants respectfully disagree with this assertion and submit the following remarks and evidence in support of their position.

As shown in the attached Declaration, based on the molecular weight and weight ratios of the developer described in Example 31 of Shimojo, the developer does not meet the claimed values for the differential molecular weight distribution of 5×10^3 (i.e, not larger than 0.55 %). The results show that in Shimojo Example 31 the ratio of differential molecular weight distribution of 5×10^3 is 0.619 %. As acknowledged at the July 8 Examiner interview, Example 31 in Shimojo is the closest prior art.

Based upon the results shown in the Declaration, and contrary to the Office Action's conclusion, Shimojo's toner in Example 31 does not have the molecular weight requirements as recited in claim 7. In addition, as recognized by the Office Action, Nanya does not teach or suggest the claimed molecular weight properties and thus fails to remedy the deficiencies of Shimojo. Therefore, the combination of Shimojo and Nanya would not have taught or suggested to one of ordinary skill in the art the claimed toner composition.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 7-10.

V. Conclusion

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1 - 20 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

H. James Voeller
Registration No. 48,015

JAO:HJV/kap

Enclosure:

Declaration Under 37 C.F.R. §1.132

Date: August 12, 2003

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

**DEPOSIT ACCOUNT USE
AUTHORIZATION**

Please grant any extension
necessary for entry;
Charge any fee due to our
Deposit Account No. 15-0461